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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/411,524	10/04/1999	GLEN A. BOUCHER	E-908	8434

7590

08/21/2002

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EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/411,524

Applicant(s)

BOUCHER ET AL.

Examiner

Mark A Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Examiner is receipt of Applicants response to the office's non-final action mailed 4/2/2002, received 8/2/2002. The response has been thoroughly reviewed, however the arguments are found to be non-persuasive. Accordingly, the rejection is restated below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Karpinski.

Karpinski teaches all the limitations of Claims 1-26. For example, Karpinski discloses a web based package-tracking system that offers a means for managing tracking systems of multiple overnight mailing couriers simultaneously, allowing a user to generate a tracking request for a package using sophisticated agents and server technology that allows an air bill to be entered once and have the system return the information when found.

Karpinski also teaches the application of E-mail/paper-message service that will be managed over the Internet and an agent application that sends out requests in the

form of scripts to the various carrier sites. What comes back is an HTML string that the system parses into records that get placed in a database and then can be accessed locally by the application. (See entire article)

Response to Arguments

Applicant's arguments filed 8/2/02 have been fully considered but they are not persuasive.

In response to applicants argument that the Karpinski is not an enabling disclosure because one skilled in the art to which the invention pertains could not take the description of the invention in the printed publication and combine it with his knowledge of the particular art and from this combination [be] put in possession of the invention on which a patent is sought. The Examiner points to the Karpinski article and the statement that "The application uses technology from software developer WebMethods Inc.". Also, see "The WebMethods Web Automation product that sits at the center of the solution, which Milestone's Reynolds describes as a "agent" application, sends out requests in the form of scripts to the various Web sites." The Examiner has provided Karpinski's reference to the home Web page for WebMethods along with 42 pages of linked articles (see PTO-892, list of related articles 1V2W,3X,4U,5V,6W,7X,8U) describing the enabling application that is the center of the invention described in the article, the combination of articles from the website being referred to herein as WebMethods website articles. Therefore, it is the Examiners position that one skilled in the art could take the disclosure of the invention in the

Karpinski and combine it with knowledge of the particular art and from this combination be put in possession of the invention as claimed in the instant application.

In regards to applicant's argument that Karpinski does not teach or suggest all the elements in the Karpinski reference, the following is provided:

In regards to claim 1, Karpinski discloses a tracking system for a shipping system in which a package is to be sent from a user to a recipient by requesting said shipping through Internet resources associated with carriers capable of delivering the package to the recipient, in which the user of the shipping system determines the carrier to be used for shipping a package to a recipient, and in which the shipping system has a shipping system server with a data storage device for storing package tracking data, comprising:

- means for generating a tracking number associated with a package to be sent from the user to the recipient by a selected carrier (WebMethods website articles, page 11, Ex. 1 and shipping and delivery services);
- means for generating a tracking request containing the tracking number associated with the package , as well as information of the particular carrier which is to deliver the package to the recipients (WebMethods website articles, page 11, Ex. 1, FedEx airbill);
- queues for storing the tracking requests (WebMethods website articles, page 27 last paragraph);
- a tracking coordinator for receipt of said tracking request and for generating tracking objects and sending said tracking objects to the tracking website of the selected carrier (WebMethods website articles, page 13, entire Object Model section);

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means for receiving results from the tracking website of the selected carrier (WebMethods website articles, page 30, see section on Building distributed object applications with the toolkit); and
means for updating the shipping server data storage with the results from the carrier website (WebMethods website articles, page 30, last paragraph).

In regards to claim 2, Karpinski teaches a tracking result queue for receiving the results from all of the

carrier websites and for outputting these results for delivery to the shipping system server data storage device (see response to claim 1).

In regards to claim 3, Karpinski teaches wherein the shipping system server has an instant tracking component for allowing a user

to generate a tracking request for a package, wherein the tracking coordinator has means for generating a tracking object for the user tracking request that is prioritized with respect to other tracking objects generated for the same carrier as that associated with the user's package (see response to claim 1).

In regards to claim 4, Karpinski teaches wherein the tracking coordinator limits the generation of tracking objects for a particular carrier so as to be generated no more frequently than a predetermined number of tracking objects per predetermined time interval (WebMethods website articles, page 29, Using the toolkit to process Web-based data).

In regards to claim 5, Karpinski teaches wherein the tracking coordinator limits the generation of tracking objects so that the total number of tracking objects generated for a particular carrier over a predetermined time interval does not exceed a predetermined number, regarding the pacing of the generation of said tracking objects WebMethods website articles (see response to claim 4, variables that can be used for programmatic access).

In regards to claim 6, Karpinski teaches wherein the tracking coordinator has means for generating tracking objects to a carrier tracking website using multiple Internet Protocol addresses (WebMethods website articles, page 29, Using the toolkit to process Web-based data).

In regards to claim 7, Karpinski teaches wherein the shipping system server includes a scheduler for automatically retrieving information required to generate a tracking request from the data storage device, wherein the scheduler times said retrieval of information to occur at a predetermined time (WebMethods website articles, page 5, both on demand and scheduled extraction of targeted websites.).

In regards to claim 8, Karpinski teaches wherein the shipping system server has an instant tracking component for allowing a user to generate a tracking request for a package, wherein the tracking coordinator has means for generating a tracking object for the user tracking request that is prioritized with respect to other tracking objects generated for the same carrier as that associated with the user's package (WebMethods website articles, page 12, Elements of WIDL).

In regards to claim 9, Karpinski teaches wherein the tracking coordinator limits the generation of tracking objects for a particular carrier so as to be generated no more frequently than a predetermined number per predetermined time interval (see response to claim 8 and 5).

In regards to claim 10, Karpinski teaches wherein the tracking coordinator limits the generation of tracking objects so that the total number generated for a particular carrier over a predetermined time interval does not exceed a predetermined number, regarding the pacing of the generation of said tracking components (see response to claim 9).

In regards to claim 11, Karpinski teaches wherein the tracking coordinator has means for generating tracking objects to a carrier tracking website using multiple Internet Protocol addresses (see response to claim 9 and WebMethods website articles, page 11, example 1).

In regards to claim 12, Karpinski teaches wherein the shipping system server includes a scheduler for automatically retrieving information required to generate a tracking request from the data storage device, wherein the scheduler times said retrieval of information to occur at a predetermined time (WebMethods website articles, page 5, Web automation: A simple introduction and claim 9).

In regards to claim 13, Karpinski teaches an E-mail services component for generating an E-mail message to a party specified by the user when the tracking information indicates that the package has been delivered to the recipient (para. 7).

In regards to claim 14, Karpinski teaches further comprising an E-mail services component for generating an E-mail message to a party specified by the user when the tracking information indicates that the package has been delivered to the recipient (WebMethods website articles, page 27, last paragraph).

In regards to claim 15-26, Karpinski teaches all the elements of the tracking method for the system in claims 1-14 (see response to claims 1-14).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]


(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner


JEFFREY A. SMITH
PRIMARY EXAMINER